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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,769	07/28/2006	Sami Saribas	019957-016830US	2116
20350 7590 04/10/2008 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				
EXAMINER MEAH, MOHAMMAD Y				
ART UNIT		PAPER NUMBER		
1652				
MAIL DATE		DELIVERY MODE		
04/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/587,769

**Applicant(s)**

SARIBAS ET AL.

**Examiner**

MD. YOUNUS MEAH

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-11 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3, 5-11 and 14 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

On 12/20/07 applicant elected group 3 ( claims 1-3, 5-11 and 14) for examination and cancelled other claims. Applicant also amended claims 1-3, 5-9. Therefore Claims 1-3, 5-11 and 14 are pending in the instant office action.

### ***Election/Restrictions***

However the Election/restriction of the prior office action of Date 11/26/07 is found to be improper. These claims need further restriction as follows:

Group I. claims 1-3, 5, 7-14, drawn to method of refolding eukaryotic ST3Gal3 protein wherein said protein fused with MBD and optionally fused with purification domain comprising starch binding domain.

Group II. claims 1-3, 5, 7-14, drawn to method of refolding eukaryotic ST3Gal3 protein wherein said protein fused with MBD and optionally fused with purification domain comprising glutathione-S-transferase domain.

Group III. claims 1-3, 5, 7-14, drawn to method of refolding eukaryotic ST3Gal3 protein wherein said protein fused with MBD and optionally fused with purification domain comprising thioredoxin domain.

Group IV. claims 1-3, 5, 7-14, drawn to method of refolding eukaryotic ST3Gal3 protein wherein said protein fused with MBD and optionally fused with purification domain comprising SUMO domain.

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Group V. claims 1-3, 5, 7-14, drawn to method of refolding eukaryotic ST3Gal3 protein wherein said protein fused with MBD and optionally fused with purification domain comprising poly-His domain.

Group VI. claims 1-3, 5, 7-14, drawn to method of refolding eukaryotic ST3Gal3 protein wherein said protein fused with MBD and optionally fused with purification domain comprising myc epitope domain.

Group VII. claims 1-3, 6, 7-14, drawn to method of refolding eukaryotic ST3Gal3 protein wherein said protein fused with MBD and having self cleaving domain.

The inventions listed in Groups I-VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical features of Groups I-VII are method steps comprising use of different protein domain fused to ST3Gal3 comprising MBD domain. Ttechnical feature linking groups 1-21 appears to be that they all related to ST3Gal3 comprising maltose binding domain. The ST3Gal3 comprising maltose binding domain does not constitute a "special technical feature" as defined by PCT Rule 13.2, because it does not claim a feature which defines a contribution over the prior art as glycosyl transferase including, ST3Gal3 comprising tag peptide

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such as maltose binding domain, glutathione-S-transferase (GST) polypeptide domain, etc is taught by Shawn et al. (WO2004099231).

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Meah whose telephone number is 571-272-1261. The examiner can normally be reached on 8:30-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mohammad Meah/

Acting Examiner of Art Unit 1652/1600

Mohammad Younus Meah, PhD

Examiner, Art Unit 1652

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